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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,152	03/27/2001	Craig A. Paulsen	IGT1P026/P000256-001	2667

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EXAMINER	
D AGOSTINO, PAUL ANTHONY	
ART UNIT	PAPER NUMBER
3714	

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08/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/819,152	PAULSEN, CRAIG A.	
	Examiner	Art Unit	
	Paul A. D'Agostino	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,13-15 and 30-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,13-15 and 30-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/12/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This responds to Applicant's Arguments/Remarks filed 05/12/2009. Claims 1 and 30 have been amended. Claims 12, 16-29, and 45-69 stand cancelled. Claims 1-11, 13-15, and 30-44 are now pending in this application.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/12/2009 has been entered.

Response to Amendments

2. This acknowledges that Applicant has amended the Claim 1 to remedy minor informalities. Thus, the objection to the Claim 1 is withdrawn.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-11, 13-15, and 30-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,110,041 to Walker et al. (Walker) in view of U.S. Patent No. 6,719,631 to Tulley et al. (Tulley).

6. Walker discloses a method and system for adapting gaming devices to a player's playing preferences. In particular, a gaming machine is networked to a central server which receives preference data from a player and configures the gaming machine to match the received preference data. The player inserts an electronic player tracking card (or other "biometric" input) to authenticate that a particular player is on a machine by transmitting data to a central server. Once this data is authenticated the central server programs or configures the gaming machine to the player's preferences. In light of Tulley, the player can view a website wherein the changes were implemented remotely on a host and then accessed by player. Walker as modified by Tulley additionally discloses:

In Reference to Claims 1, 30, 38, 42, and 44

a master gaming controller (Fig. 3 “CPU” slot machine controller (310)) configured to control a game played on the gaming machine and to configure the gaming machine by requesting preference account information from a remote server {external storage unit} (Fig, 1 “Slot Network Server" 110; also, Col. 2, Lines 14-49, Col. 3, Lines 29-41, Col, 7, Line 47-Col. 8, Line 6, and Figures 1-11B); wherein the preference account information comprises preferred gaming machine settings to configure the gaming machine using the preference account information received from the remote server to output to a video display a user interface that is generated on the gaming machine and configured to display preferences in response to commands and data received from the remote host server ("Preferences selection....displayed on video display area 346" Col. 7 Lines 1-5 wherein “a server consistent with the present invention for configuring a slot machine to playing preferences comprises a device for storing a collection of data representing various operations of the slot machine and a device for selectively transmitting a portion of the stored collection of data to the slot machine as preference data” Col. 2 Lines 35-41), and authenticating the request (Fig. 10A step 1010-1015); said user interface configured to allow a user to modify the preference account information (“allow players to customize slot machines easily to their player preferences” Col. 2 Lines 14-15); to receive data from the remote host for generating the user interface on the video display ("if the player does have established preferences (step 1025 [Fig. 10A]), slot network server 110 accesses player preferences database 216 and transmits the preferences

data corresponding to that player's identification number to slot machine 120 (step 1030)" Col. 8 Lines 7-16); to send information associated with preferences selections entered via the user interface to the remote host (Fig. 9 step 920 and Col. 7 Lines 52-63); to configure the gaming machine using the preference selections entered via the user interface (Fig. 10B step 1040); to receive a wager on an outcome for the game, determine the outcome for the game, and generate a game presentation of the outcome determined for the game on the video display (Col. 6 Lines 10-25); to output a video display (Fig. 3 "Video display Area" 346) of the user interface generated on the gaming machine in response to commands and data received from the remote host;

the video display under the control of the master gaming controller, the game presentation of the outcome (system and method performs this intended use; Figs. 1-3 and Fig. 10B steps 1040-1045);

a memory configured to store gaming software that allows the master gaming controller to request one or more different portions of the preference account information from the remote server (Abstract, Column 2, lines 14-49, Column 3, lines 29-41, and Figures 1-11B), wherein the preference account information includes at least one or more items selected from the group consisting of for example, preferred gaming machine settings and preferred service options (Figs. 4-8); account summary (Figure 5); promotional opportunity (Figure 8 (Comp Rate, Comp Specs), Column. 3, Lines 42-45, Column 4, Lines 49-64, and Column 5, Lines 32-36, and 42-60); and the information regarding one or more preferences in a group of available preferences includes information about an award (Claim 12); and

However, Walker fails to disclose wherein the game outcome presentation is generated on the remote host using the preference selections received at the gaming machine and sent to the remote host from the gaming machine and output via the user interface. Walker discloses the claimed invention except for the fact that the display is generated at the gaming machine with commands inputted at the gaming machine and stored on the server rather than the display being generated at the server.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to gererate the display at the server, since it has been held that constructing a formerly integral structure into various elements involves only routine skill in the art. Nerwin v. Erlichman, 168 USPQ 177, 179.

Alternatively, Tulley disclose remote system for event parameters based on player selections (Title) wherein the game outcome presentation is generated on the remote host using the preference selections received at the gaming machine (Col. 5 Lines 25-35) and sent to the remote host from the gaming machine and output via the user interface (“According to another embodiment, the player uses his or her PC as a lottery device and communicates with the controller 300 via a lottery Web site. In this case, various player preferences (e.g., favorite event formats and/or event parameters) and/or the payment identifier may be stored as a "cookie," or block of data that a Web server (e.g., the controller 300) stores on a client system (e.g., the player's PC). When the player returns to the lottery Web site, or an associated Web site, the browser of the player's PC sends a copy of the cookie back to the Web server. Cookies may be used to identify players associated with a player device 200, to instruct the Web server to

send a customized version of a Web page, and for other purposes" Col 15 Lines 37-50). Tulley provides this system and method in order to provide "an offline remote lottery system which enables a player to purchase instant-type lottery system outcomes from a central computer" (Col. 2 Lines 9-11) in accordance with "player established event parameters" Col. 2 Lines 19-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the remote generation of the display which can be accessed on the gaming machine or PC that have browser capability over the Internet as taught by Tulley into the teachings of Walker in order to provide an offline remote gaming system which enables a player to purchase outcomes from a central computer in accordance with player established event parameters.

Regarding Claims 2 and 39

Walker as modified by Tulley discloses wherein two different portions of the preference account information are requested on the remote server (Abstract, Column 2, lines 14-49, Column 3, lines 29- 41, and Figures 1-11B).

Regarding Claims 3, 6, 31, and 34

Walker as modified by Tulley discloses wherein the loyalty point account information comprises an amount of loyalty points rewarded during a particular event (Column 5, lines 42-60).

Regarding Claims 4 and 32

Walker as modified by Tulley discloses wherein the particular event comprises a game play (Column 5, lines 42-60).

Regarding Claims 5 and 33

Walker as modified by Tulley discloses wherein the loyalty account settings selected based on name or address (Fig. 4).

Regarding Claims 7 and 35

Walker as modified by Tulley discloses wherein the preferred game is a slot machine (Column 3, lines 61-64).

Regarding Claims 8, 9, 36, and 37

Walker as modified by Tulley discloses wherein the preferred gaming features and settings are game presentation speed or game audio features (Column 5, lines 1-5).

Regarding Claims 10, 11, and 43

Walker as modified by Tulley discloses wherein biometric input device designed to receive biometric information from a player, such as, a fingerprint or retina scan (Column 6, lines 47-61).

Regarding Claim 13

Walker as modified by Tulley discloses wherein the user interface is compatible with a web browser (Column 9, lines 27- 35).

Regarding Claims 14, 15, and 40

Walker as modified by Tulley discloses wherein one or more input devices designed to input preference account information, including a video touch screen, a card reader, keypad, etc. (Figures 3, and 9-11B, and Column 6, lines 39-61).

Regarding Claim 41

Walker as modified by Tulley discloses wherein an interface (display screen (346)) designed to display preference account information (Abstract, Column 2, lines 14-49, Column 3, lines 29-41, Column 7, line 47-Column 8, line 6, and Figures 1-11B).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

9. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-11, 13-15, and 30-44 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 21-32 of copending Application No. 11/830,796. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim a gaming device, user interface, memory, and display of a system and method for sending and receiving the selection and databasing of player preferences. This is a

provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

11. Applicant's arguments filed 5/12/2009 have been fully considered and are persuasive. Applicant argues (see Applicant's Arguments/Remarks pages 9-11) that Matthews teaches of pre-specified selectable multimedia choices for players to elect as preferences. Examiner concurs and from this better appreciates what it is Applicant is claiming. Applicant is now directed back to the disclosure of Walker wherein for brevity the response to Applicant's argument is provided as part of the grounds for rejection. Applicant also argues that the combination of references fail to disclose a simulated game outcome reflecting the player preferences which is generated on the remote host. Examiner respectfully disagrees and has responded in the rejection of the claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is provided in the Notice of References Cited.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Supervisory Patent Examiner, Art Unit 3714

/Paul A. D'Agostino/
Examiner, Art Unit 3714